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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,160	09/30/2003	Go Yuasa	107391-00001	9825

7590 06/06/2005
ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
Suite 600
1050 Connecticut Avenue, N.W.
Washington, DC 20036-5339

EXAMINER

BEHNCKE, CHRISTINE M

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,160

Applicant(s)

YUASA, GO

Examiner

Christine M. Behncke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 2 is/are rejected.
7) ☒ Claim(s) 3 and 4 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/19/05 & 9/30/03.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the application filed 30 September 2003, in which claims 1-4 were presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/673159. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the application of issue contains the same limitations as claim 1 of the copending application except "wherein said second execution module executes said second computer program by using transferred data of said data which are transferred data of said data which are transferred from said second recording device to said first recording device". However, this limitation does not change the scope of the claim since the claim already states the

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second execution module executes the second computer program, which stores the original data that is transferred to the first recording device, concurrently with the operation of the installation module.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Inventorship

3. The Examiner brings attention to possible question of proper inventorship of the claims of issue in light of copending Application No. 10/673159. The copending Application discloses subject matter that, while not identical, is not patentably distinct from the claims of issue, as highlighted by the Double Patenting rejection for claim 1. However, Examiner notices there is only one common inventor, Go Yuasa, between the applications. The Examiner questions how the slightly more limited claim, claim 1 of issue, was invented without the other inventors of the broader claim of the copending Application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nagaki, US Patent Application Publication No. 2001/0004724.

Nagaki discloses a vehicle navigation system comprising: first and second recording devices (Hard disc 15 and DVD-ROM 1) storing therein first and second computer programs ([0069] and [0064]-[0065]), respectively, wherein said first and second computer programs are used for vehicle navigation; a first execution module executing said first computer program (Hard drive 15); a second execution module executing said second computer program (DVD-ROM drive 14); an install module transferring data stored in said second recording device to said first recording device (RAM 13), wherein said install module and said second execution module concurrently operate ([0102] and [0106]), and said first execution module is prohibited from operating during operation of said second execution module ([0103]), wherein said second execution module executes said computer program by using transferred data of said data which are transferred from said second recording device to said first recording device (figure 8 and [0106]-[0107]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaki in view of Ahrens et al., US Patent No. 6,018,695.

Nagaki discloses the vehicle navigation system wherein data is stored in a second recording device but does not specifically disclose the data is compressed. However, Ahrens et al. teaches updating a vehicle navigation system with updated navigational data wherein the data/programs are contained on a storage medium and in compressed form (Column 19, lines 57-60). Ahrens et al. further teaches wherein an installation module decompresses the data and transfers the decompressed data to a first recording device (Column 19, lines 57-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Nagaki with the teachings of Ahrens et al. because it is well known in the art of electronics that recording compressed data onto a storage medium or transmitting the compressed data takes less time and storage space because of the relatively small size of the data packets.

Allowable Subject Matter

6. **Claims 3 and 4** are objected to as being dependent upon a rejected base claim and are at present considered to overcome the prior art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

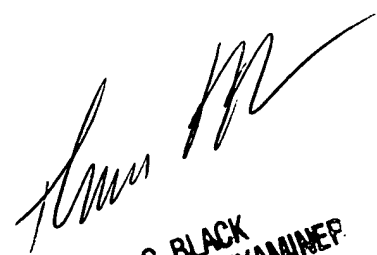
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine M. Behncke whose telephone number is (571) 272-8103. The examiner can normally be reached on Monday - Friday 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

05-26-2005


THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 7600